

Applicants: Stinson, J.
Application No: 10/721,702
Response to Restriction Requirement dated July 24, 2006
Restriction Requirement dated June 26, 2006
Page 2

The Examiner has restricted the invention under 35 U.S.C. §121 into the following groups:

- I. Claims 30 and 44-59, drawn to a bioabsorbable element, classified in class 623, subclass 23.75
- II. Claims 60-75, drawn to a bioabsorbable endoprosthesis, classified in class 623, subclass 1.38.

Applicants provisionally elect to prosecute Group I, claims 30 and 44-59, with traverse.

The Examiner has stated that the inventions are distinct, each from the other because inventions I and II are related, as product and process of use. The Examiner, however, does not specifically allege why the species are patentably distinct.

Applicants' acknowledge that under MPEP, §806.05(c) that inventions are distinct if the following can be shown:

- (1) that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and
- (2) that the subcombination has utility by itself or in other combinations.

The Examiner has not, however, specifically alleged why the inventions are distinct. According to MPEP 803, the restriction is proper only if the claims are able to support separate patents and they are either independent or distinct (806.05-806.05(h)). Section 803 also states that even if distinct or independent claims exist, examination on the merits is required providing the search can be made without serious burden.

Applicants: Stinson, J.
Application No: 10/721,702
Response to Restriction Requirement dated July 24, 2006
Restriction Requirement dated June 26, 2006
Page 3

In the instant case, it is apparent from a thorough reading of the specification and the claims that the elements and prostheses of Groups I and II are one invention in this application. References which disclose the prostheses of Group II would clearly be cited as prior art against those which disclose the elements of Group I. The Examiner would certainly feel obligated to consider such disclosure relevant and would not hesitate to cite references relating to one group against the other under 35 U.S.C. §103. For those reasons, Applicants maintain that a co-extensive field of search seems virtually mandated and would not present an undue burden.

Furthermore, the mere fact that of separate classifications is not determinative of a proper restriction. Separate classification is mere a patent office convenience for the purpose of locating pertinent art. It is clear, therefore, that although diversity of classification may be the considered factor in a decision to make a restriction requirement, it should not be a controlling one. The Examiner may not properly rely on separate classifications to support an allegation of separate status in the art. The Examiner has also not made any further allegations as to why this restriction is proper.

For the reasons set forth above, Applicants respectfully request that the requirement for restriction to be withdrawn and consideration of all the claims on the merits be commenced.

Applicants: Stinson, J.
Application No: 10/721,702
Response to Restriction Requirement dated July 24, 2006
Restriction Requirement dated June 26, 2006
Page 4

Furthermore, the Examiner alleges that the claims are directed towards the following distinct species:

Species A: Fig. 2a;
Species B: Fig. 2b; and
Species C: Fig 2d.

Applicants provisionally elect species A, i.e., species of Fig. 2a showing a hollow member having at least one elongate, axially extending reservoir portion.

Applicants respectfully submit that claims 30, 44 and 46-59 read on Species A as defined by the Examiner of Group I with claim 30 being generic within this group.

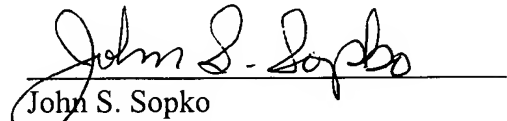
Furthermore, Applicants respectfully submit that any of the claims 30 and 44-59 that are directed to a non-elected species depend from the generic claim 30. Upon indication of allowance of the generic claims, Applicants respectfully request allowance of the claims directed towards the non-elected species.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

Applicants: Stinson, J.
Application No: 10/721,702
Response to Restriction Requirement dated July 24, 2006
Restriction Requirement dated June 26, 2006
Page 5

Should the Examiner have any questions, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number set forth below.

Respectfully submitted,


John S. Sopko
Reg. No. 41,321
Attorney for Applicants

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(973) 331-1700